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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,572	04/18/2005	Takashi Kenmoku	03500.017652	2325
5514 7590 07/02/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER HANLEY, SUSAN MARIE				
ART UNIT		PAPER NUMBER		
1651				
MAIL DATE		DELIVERY MODE		
07/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,572

Applicant(s)

KENMOKU ET AL.

Examiner

SUSAN HANLEY

Art Unit

1651

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/3/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-37 is/are pending in the application.
- 4a) Of the above claim(s) 22, 23 and 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

The reply filed 3/3/08 is acknowledged.

Priority

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Applicant has provided a certified translation of only the claims for JP2002-309786 (filed 2/14/08). A certified translation of the entire foreign priority document is required to perfect the foreign priority claim. A translation of the entirety of the foreign priority document is necessary in order to determine the sufficiency of the disclosure under 35 U.S.C. 112, as well as to determine if there is a basis for the claims sought.

Applicant is directed to MPEP 2115:

The most important aspect of the examiner's action pertaining to a right of priority is the determination of the identity of invention between the U.S. and the foreign applications. The foreign application may be considered in the same manner as if it had been filed in this country on the same date that it was filed in the foreign country, and the applicant is ordinarily entitled to any claims based on such foreign application that he or she would be entitled to under our laws and practice. The foreign application must be examined for the question of sufficiency of the disclosure under 35 U.S.C. 112, as well as to determine if there is a basis for the claims sought.

Election/Restrictions

The lack of unity made on 10/9/07 was based on Yano et al. (EP 1,340,776; cited in the IDS filed 4/18/05). A polyhydroxyalkanoate comprising the monomer of formula (1) has been disclosed by as formula (38) on page 27. Since this monomer has been disclosed by the prior art, the invention lacks a special technical feature over the prior art. It is noted that the date of the Yano document falls after the effective filing date for this national stage application (10/23/03) and the dates of the documents for which foreign priority has been claimed (JP 2002-309786, filed 10/24/02, and JP 2003-356749, filed 10/16/2003).

A certified translation of at least one document that meets the requirements of MPEP 201.15 has not been filed. Hence, the foreign priority claim has not been perfected. Thus, the date of the Yano document predates the effective filing date of this application, and is properly used as prior art.

Claim Rejections - 35 USC § 102

Claims 1 and 4 stand rejected under 35 U.S.C. 102(a) as being clearly anticipated by Yano et al. (EP 1,340,776; cited in the IDS filed 4/18/05).

Applicant argues that a verified translation of the granted claims has been filed with the request for participation in the PPH. Applicant asserts that said translation clearly demonstrates that the present claims are fully supported by the priority application and that the priority date of the instant invention is now based on that of JP 2002-309786, filed 10/24/02.

Applicant's argument is found non-persuasive because the claim for foreign priority has not been perfected. Applicant cannot rely upon the certified translation of only the claims of foreign priority papers to overcome this rejection because the foreign application must be examined for the question of sufficiency of the disclosure under 35 U.S.C. 112, as well as to determine if there is a basis for the claims sought. Hence, a certified translation of the entire foreign priority document is required.

Claims 21 and 24 stand rejected under 35 U.S.C. 102(e) as being anticipated by US 6,911,520, US 6,908,721, US 6,649,380 or US 6,645,743.

Applicant argues that cited patents all have a filing date in 2003. Applicant argues that a verified translation of the granted claims has been filed with the request for participation in the PPH. Applicant asserts that said translation clearly demonstrates that the present claims are fully supported by the priority application and that the priority date of the instant invention is now based on that of JP 2002-309786, filed 10/24/02.

Applicant's argument is found non-persuasive because the claim for foreign priority has not been perfected. Applicant cannot rely upon the certified translation of only the claims of foreign priority papers to overcome this rejection because the foreign application must be examined for the question of sufficiency of the disclosure under 35 U.S.C. 112, as well as to determine if there is a basis for the claims sought. Hence, a certified translation of the entire foreign priority document is required.

Double Patenting

Claims 21 and 24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,911,520.

Claims 21 and 24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,908,721.

Claims 21 and 24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,649,380.

Applicant argues that the filing of a terminal disclaimer at this time is premature and expensive.

Applicant's argument is not directed to the factual basis of the rejection and is, therefore, non-persuasive. The rejections stand for the reasons of record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN HANLEY whose telephone number is (571)272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Hanley/
Examiner, Art Unit 1651

/Sandra Saucier/
Primary Examiner, Art Unit 1651